

ESTTA Tracking number: **ESTTA611263**

Filing date: **06/20/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92056317
Party	Plaintiff Cockpit USA, Inc.
Correspondence Address	E COOKE RAND RAND ROSENZWEIG RADLEY & GORDON LLP 800 THIRD AVENUE, SUITE 2604 NEW YORK, NY 10022 UNITED STATES ccampbell@randrose.com,erand@randrose.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Catherine S Campbell
Filer's e-mail	ccampbell@randrose.com,erand@randrose.com
Signature	/Catherine S Campbell/
Date	06/20/2014
Attachments	Motion.Leave to Amend Petition.pdf(55849 bytes) Affirmation of Catherine Campbell.pdf(63938 bytes) Ex 1 to Campbell Affirmation.pdf(1189222 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

.....

COCKPIT USA, INC.,

Petitioner,

v.

TOP GUN INTELLECTUAL
PROPERTIES LLC,

Registrant.

Cancellation No. 92056317

Registration No. 2817325

.....

PETITIONER’S MOTION FOR LEAVE TO FILE AN AMENDED
PETITION TO CANCEL AND MEMORANDUM OF LAW IN SUPPORT

Petitioner, Cockpit USA, Inc. (“Petitioner” or “Cockpit”), by its attorneys Rand
Rosenzweig Radley & Gordon LLP, hereby moves the TTAB for leave to file an amended
petition to cancel Registration No. 2817325, pursuant to Fed.R.Civ.P. 15(a) and TBMP § 507
(“Motion”). In support of the Motion, Petitioner submits the accompanying Affirmation of
Catherine S. Campbell, Esq., dated June 20, 2014 (“Campbell Aff.”) with accompanying
exhibits, including a proposed amended petition (“Amended Petition”). As permitted by 37
C.F.R. §2.127(a), Petitioner’s memorandum of law in support of its Motion is incorporated
herein.

BACKGROUND

On October 12, 2012, Cockpit filed a petition (“Petition”) for cancellation of Registration
No. 2,817,325 (“Reg. ‘325”) for the mark “Top Gun” (the “Mark”) in IC 25 owned by Top Gun
Intellectual Properties, LLC (“Registrant”). The grounds alleged in the Petition for cancellation
were fraud on the USPTO in the Registrant’s (i) declaration of application, (ii) declaration of use

under Section 8, and (iii) declaration of incontestability under Section 15, and for cancellation of the Mark as to flight jackets as generic. Reg. '325 issued on February 24, 2004 registered the Mark for the following listed goods: "Footwear, shoes, sandals; Clothing, namely, leather jackets, sports coats, jeans, sweatshirts, T-shirts, caps, hats, belts, and excluding protective clothing and work gloves" (the "Listed Goods"). On September 10, 2009, Registrant filed a Combined Declaration of Use and Incontestability under Sections 8 & 15 with respect to Reg. '325 ("Combined Declaration"), declaring use of the Mark for all of the Listed Goods and continuous use of the Mark for the prior five years for all of the Listed Goods.

TTAB Order Deciding Registrant's Motion to Dismiss

On November 26, 2012, Registrant moved to dismiss the Petition in its entirety for failure to state a claim upon which relief can be granted. Petitioner opposed the motion to dismiss. The TTAB issued a decision on March 6, 2013 finding the Petitioner had adequately pled (i) fraud in Registrant's declaration of application and (ii) use of the Mark with flight jackets as generic, thereby sustaining the Petition as to these two claims. The TTAB decision struck paragraphs 22-33 of the Petition which represented Petitioner's two claims for fraud in Registrant's Combined Declaration. In particular the TTAB decision found that the "petitioner has not identified the specific goods that were allegedly not in use" at the time of the Combined Declaration filing. The TTAB's Order reactivated the case and set the time to answer for April 4, 2013.

Thereafter, the parties entered into settlement negotiations and the TTAB authorized the suspension of the proceeding for settlement purposes, from April 4, 2013 to June 6, 2014. (*See* TTAB document nos. 10-26). The parties undertook settlement negotiations during that period, but were not successful.

Thus, Petitioner brings this motion and, in the accompanying proposed Amended Petition, specifies that “shoes, sandals, sports jackets and jeans” are the four listed goods not in use at the time of filing and continuously for the five consecutive years after registration, making Registrant’s claims of use in the Combined Declaration false. Petitioner moves for leave to replead these two claims, as re-stated in the proposed Amended Petition, on the following grounds.

Personal Investigation of Facts Supporting Claims of Fraud in Combined Declaration

As more fully detailed in the Campbell Aff. and the proposed Amended Petition (Exhibit 2 to the Campbell Aff.), counsel for Petitioner personally investigated the facts supporting its claims that upon information and belief Registrant committed fraud on the USPTO in the filing of its Combined Declaration. On September 11, 2012, Petitioner’s counsel reviewed the website for Registrant’s owner, Ayal Hod at www.topgunstore.com (“Online Store”), at the time the Petition was being drafted. Counsel found that the Online Store advertised for sale, men’s and women’s clothes and accessories, and children’s leather jackets but was not offering footwear, shoes, sandals, sports coats or jeans for sale. On January 4, 2013 in preparing the opposition to the motion to dismiss, counsel again investigated the Online Store, and again found that Registrant’s owner was not offering footwear, shoes, sandals, sports coats or jeans for sale. *See* Campbell Aff. at ¶¶ 5-9 & Ex. 1.

Whether Registrant has ever offered footwear, shoes, sandals, sports coats or jeans for sale under the Mark, as listed in its Registration at the time of the Combined Declaration filing and continuously for the five consecutive years after registration, is information uniquely in the control of Registrant, and essential information which Petitioner does not have access to at this pleading stage.

Moreover as presented in the portion of the Petition sustained by the TTAB decision, prior to filing the trademark registration application for Reg. '325, Hod was in business for many years with Petitioner, commencing in July 1996 until approximately March 2003. During that period, Hod operated under the business name of T.G. Request, Inc. and purchased products under the Mark from Petitioner for resale in his retail outlets. (*See* Amended Petition at ¶¶ 9-12). Petitioner's records of these sales demonstrate that Hod falsely stated to the USPTO in the registration application that "he knows of no other person, firm, corporation, or association that has the right to use the mark TOP GUN . . ." (Amended Petition at ¶ 19). Given this evidence and counsel's discovery that the Online Store was not offering shoes, sandals, sports coats or jeans for sale in 2012 and 2013, it can reasonably be believed that Registrant also falsely declared in the Combined Declaration that the Mark was used in commerce at the time of the filing and continuously for the five consecutive years after registration as to each one of the Listed Goods. However, unlike Petitioner's allegations on the claim for fraud on the USPTO in the registration application, the records and knowledge of the facts supporting Petitioner's claims of fraud in the Combined Declaration are wholly within the purview of Registrant and/or its owner, Hod.

LEGAL ARGUMENT

Motions for Leave to Amend Liberally Granted

Motions for leave to amend a cancellation petition are liberally granted where the pleading was originally dismissed for failure to adequately plead fraud under the requirements of F.R.C.P. Rule 9(b). *See* F.R.C.P. 15(a); TBMP § 507.02; *Laurel Avenue Café Corp. v. Lost Dog Café Corp.*, Opposition No. 114,395, 2001 WL 460106, at *2 (T.T.A.B.) (leave to amend granted where opposer failed to submit a sufficiently pleaded claim of fraud). The TBMP states that the Board should “liberally grant leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties.” TBMP § 507.02.

If this motion is granted, Registrant will not be prejudiced. Registrant has knowledge of the goods listed in its Combined Declaration and the import of its declaration executed in that filing. Therefore, the particularized pleadings can come as no surprise to Registrant, especially in light of the TTAB Order requiring such specificity in any amended petition. Petitioner should seek leave to file. The proposed Amended Petition simply provides the facts upon which Petitioner’s original claims of fraud relating to the Combined Declaration were based. *Hana Financial Inc. v. Hana Bank*, 500 F. Supp. 2d 1228, 1233, 1238 (C.D. Cal. 2007) (“‘leave to amend should be granted unless ... the pleading could not possibly be cured by the allegation of other facts.’”) (quoting *Vess v. Ciba-Geigy Corp USA*, 317 F.3d 1097, 1108 (9th Cir. 2003); *Bly-Magee v. California*, 236 F.3d 1014 (9th Cir. 2001).

Petitioner's Proposed Amended Petition Supports
its Claims of Fraud in the Combined Declaration
by Alleging the Specific Facts of its Claims

The proposed Amended Petition identifies shoes, sandals, sports coats and jeans as the specific goods listed in the Combined Declaration that Petitioner alleges were not used under the Mark at the time of the filing or continuously for the five consecutive years after registration. (See Amended Petition at ¶¶ 27-30, 36). Additionally, the Amended Petition alleges the facts of the separate personal investigations undertaken prior to the filing of the Petition and during drafting of opposition to Registrant's motion to dismiss, which show that footwear, shoes, sandals, sports coats and jeans were not offered for sale by Registrant's owner's online store at those times. This investigation provides the basis for Petitioner's claims on information and belief that these goods were not being used in connection with the Mark in commerce by Registrant contrary to its declaration in the Combined Declaration. (See *id.* at ¶ 15; Campbell Aff. at ¶¶ 5-9).

As the TTAB has stated, "to satisfy Fed. R. Civ. P. 9(b), allegations based on 'information and belief' must be accompanied by a statement of facts upon which the belief is founded." *Petróleos Mexicanos v. Intermix S.A.*, 2011 WL 586300 (TTAB 2012) (finding petitioner's amended allegations of personal investigation meet this requirement). Thus, the courts and the TTAB have accepted that allegations upon information and belief of fraud can satisfy the particularity requirements of Rule 9(b), when the factual basis for the information and belief are included in the pleadings. See *id.*; *Meckatzer Löwenbräu Benedikt Weiß KG v. White Gold, LLC*, 2010 WL 2561535 (TTAB) (in denying motion to dismiss, TTAB found Rule 9(b) met by "allegations not solely on 'information and belief' but also based on the results of an

investigation which . . . revealed that respondent was not using its mark on all of the goods listed in its Statement of Use”).

Moreover, when allegations are based in part on a party’s investigations, Rule 9(b) requires only that the pleadings set forth the facts upon which the belief is founded, and is not required to allege the facts that are uniquely within the control of the adverse party. *Exergen v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1330 (Fed. Cir. 2009) (“Pleading on ‘information and belief’ is permitted under Rule 9(b) when essential information lies uniquely within another party’s control, but only if the pleading sets forth the specific facts upon which the belief is reasonably based.”); *Bauer Bros. LLC v. Nike, Inc.*, No., 2011 WL 843971 at *6 (S.D. Ca.); *cf. Simonian v. Pfizer, Inc.*, 2011 WL 780836 at *2 (N.D. Ill.) (on false marketing claim, motion to dismiss denied and particularity requirements of Rule 9(b) satisfied where complaint alleged specific facts upon which belief was based) (citing *Exergen Corp.*).

Petitioner’s proposed Amended Petition cures the original deficiencies by pleading the personal investigation undertaken of publically available information regarding its claims of fraud in the Registrant’s Combined Declaration. As the Campbell Aff. details and is specifically pled in the Amended Petition, Petitioner presents the facts of the personal investigation supporting its claims that Registrant’s sworn statements of use and continued use in the Combined Declaration are false. Thus, on September 11, 2012 and January 4, 2013, the online store related to Registrant was not offering for sale four of the goods listed in the Statement of Use for Reg. ‘325 and which are not excluded from the Combined Declaration. *See* Campbell Aff. at ¶¶ 4-6. Moreover, Petitioner has successfully pled a claim for fraud as to the declaration in the registration application for Reg. ‘325 based on the multi-year business dealings between Petitioner and Registrant’s affiliates. (*Id.* at ¶ 8). These known facts support Petitioner’s

allegations that upon information and belief, Registrant falsely declared that it was offering these goods for sale at the time of the filing of the Combined Declaration and continuously for the five consecutive years after the registration. *Meckatzer*, 2010 WL 2561535 (denying motion to dismiss where pleadings included the results of an investigation revealing respondent was not using its mark on all the goods listed in its statement of use).

Thus, Petitioner has sufficiently identified in the proposed Amended Petition not only the specific goods in the Combined Declaration that it claims on information and belief were not in use, but also pled the additional facts supporting its allegations upon information and belief of fraud in the Combined Declaration, thereby satisfying the particularity requirements of Rule 9(b).

CONCLUSION

In conclusion, Petitioner respectfully requests of the TTAB leave to file the proposed Amended Petition realleging the facts in support of its claims for cancellation of Reg. '325 based upon fraud on the USPTO with regard to Registrant's Section 8 declaration and Section 15 declaration.

Dated: June 20, 2014
White Plains, N.Y.

_____/s/_____
Catherine S. Campbell, Esq.
RAND ROSENZWEIG RADLEY &
GORDON LLP
445 Hamilton Avenue, Suite 1201
White Plains, New York 10601
Tel: (914) 406-7000
Attorneys for Petitioner

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

.....
Cockpit USA, Inc.

Petitioner,

v.

Cancellation No. 92056317
Registration No. 2817325

Top Gun Intellectual Properties
LLC,

Registrant.
.....

AFFIRMATION OF CATHERINE S. CAMPBELL, ESQ.
IN SUPPORT OF PETITIONER’S MOTION FOR LEAVE
TO FILE AMENDED PETITION OF CANCELLATION

CATHERINE S. CAMPBELL, ESQ., declares the following under penalties of perjury:

1. I am a member of the firm of Rand Rosenzweig Radley & Gordon LLP, attorneys for Petitioner, Cockpit USA, Inc. (“Petitioner”), in the above captioned matter. I make this declaration upon personal knowledge based on documents in my possession and actions I have taken. Attached hereto as Exhibit 1 is a copy of Petitioner’s proposed amended petition for cancellation (“Amended Petition”), which Petitioner respectfully requests leave of the TTAB to file in this proceeding.

2. I prepared the initial pleadings in this proceeding for cancellation of Registration No. 2817325 (“Reg. ‘325”) for the mark “Top Gun” (the “Mark”) which was filed on October 12, 2012 (“Initial Petition”). The Initial Petition pled four grounds for the cancellation of Reg. ‘325: (i) fraud on the USPTO in the registration application; (ii) fraud on the USPTO in the Section 8 declaration filing; (iii) fraud on the USPTO in the Section 15 declaration filing; and

(iv) use of the Mark with flight jackets as generic. Registrant, Top Gun Intellectual Properties LLC (“Registrant”) moved to dismiss the Initial Petition in its entirety.

3. On March 6, 2013, the TTAB issued its decision denying sustaining Petitioner’s claims of fraud in the registration application and genericness as to flight jackets. The TTAB dismissed that portion of the Initial Petition claiming fraud on the USPTO in the combined declaration filed for Reg. ‘325 (“Combined Declaration”). This Affirmation is made in support of Petitioner’s motion for leave to replead its two claims for fraud on the USPTO by Registrant in its Combined Declaration.

4. Registrant’s owner is Ayal Hod (“Hod”), who was the initial owner of Reg. ‘325 until he assigned it to Registrant in 2007. In preparing the Initial Petition, on September 11, 2012, I undertook Internet research of a website at www.topgunstore.com (“Online Store”), which website states it is owned by Hod. The Online Store advertised for sale, men’s and women’s clothes and accessories, and children’s leather jackets. I found that on September 11, 2012, Hod’s Online Store was not offering shoes, sandals, sports coats or jeans for sale.

5. Based on this information, the Initial Petition pled on information and belief that Registrant’s Combined Declaration was false because as of the date of that declaration Registrant was not selling and was not continuously selling for the five consecutive years after registration all of the goods listed in Reg. ‘325 (“Listed Goods”).

6. On January 4, 2013, while preparing papers in opposition to Registrant’s motion to dismiss, I again viewed Hod’s Online Store to determine what the website offered for sale. Attached as Exhibit A to the Amended Petition is a copy of the pages I printed from the Online Store showing the men’s and women’s clothing and accessories that the Online Store did offer

for sale on January 4, 2013. As was the case when I viewed the Online Store on September 11, 2012, the Online Store was not offering shoes, sandals, sports coats or jeans for sale.

7. The proposed Amended Petition pleads with specificity that Registrant's filing of the Combined Declaration was a fraud on the USPTO by falsely stating that it used the Mark in connection with its offer for sale of shoes, sandals, sports coats and/or jeans at the time of the filing and for the five consecutive years after registration. (*See* Amended Petition at ¶¶ 22-42). The Amended Petition further presents the results of my investigation of Hod's Online Store in September 2012 and January 2013 as the basis for these allegations. (*Id.* at ¶¶ 25, 35). Records showing whether any or all of the Listed Goods were sold under the Mark at the time of the Combined Declaration filing and continuously for the five consecutive years after registration, are solely in the possession of Registrant and/or Hod. Therefore, the allegations specific to Registrant's false declaration of use of the Mark with regard to shoes, sandals, sports coats and/or jeans are properly pled in the Amended Petition "upon information and belief and upon the results of the investigation. . . ." (*Id.* at ¶¶ 26-29, 36-39).

8. As pled in the portion of the Initial Petition sustained by the TTAB decision, prior to filing the trademark registration application for Reg. '325, Hod was in business for many years with Petitioner, commencing in July 1996 until approximately March 2003. During that period, Hod operated under the business name of T.G. Request, Inc. and purchased products under the Mark from Petitioner for resale in his retail outlets. (*See* Amended Petition at ¶¶ 9-12). I personally reviewed records of Petitioner that show that T.G. Request, Inc. purchased "Top Gun" products from Petitioner from July 1996 through March 2003. These records evidence that Hod falsely stated to the USPTO in the registration application that "he knows of no other person, firm, corporation, or association that has the right to use the mark TOP GUN . . ."

(Amended Petition at ¶ 19). Given this evidence and the fact that on the two dates I researched the Online Store, it was not offering shoes, sandals, sports coats or jeans for sale, it can reasonably be believed that Registrant also falsely declared in the Combined Declaration that the Mark was used in commerce at the time of the filing and continuously for the five consecutive years after registration as to each one of the Listed Goods. Unlike Petitioner's allegations on the claim for fraud on the USPTO in the registration application, the records and knowledge of the facts supporting Petitioner's claims of fraud in the Combined Declaration are wholly within the purview of Registrant and/or its owner, Hod. Therefore, I submit that the pleadings as amended sufficiently state with specificity that upon information and belief, the Combined Declaration falsely declares that the Mark was used in connection with the offer for sale of shoes, sandals, sports coats or jeans at the time of the filing and continuously for the five consecutive years after registration.

9. I respectfully request that the TTAB grant Petitioner's request for leave to file the proposed Amended Petition.

Dated: June 20, 2014
White Plains, N.Y.

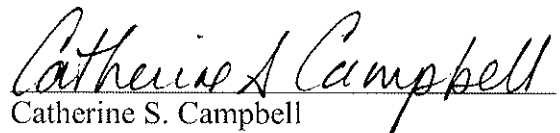

Catherine S. Campbell

EXHIBIT 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

.....
Cockpit USA, Inc.

Petitioner,

v.

Cancellation No. 92056317
Registration No. 2817325

Top Gun Intellectual Properties
LLC,

Registrant.
.....

AMENDED PETITION FOR CANCELLATION

Petitioner Cockpit USA, Inc. (“Petitioner”), by its attorneys, Rand Rosenzweig Radley & Gordon LLP, for its amended petition, alleges that it is damaged by Registration No. 2,817,325 (“Reg. ‘325”), and hereby petitions to cancel the same. The grounds for cancellation are as follows:

1. Petitioner is a New York corporation, having a place of business at 15 West 39th Street, New York, New York, 10018. Petitioner was incorporated as Avirex Ltd; in 2006 Petitioner’s corporate name was changed to Cockpit USA, Inc.

2. Upon information and belief, the current owner of Reg. ‘325 is Top Gun Intellectual Properties LLC (“Registrant”), a New York limited liability company with a business address of 31-65 Steinway, Astoria, N.Y. 11103. The original registrant of Reg. ‘325 was Ayal Hod (“Hod”). Hod assigned Reg. ‘325 to Registrant on July 16, 2007. Hod executed the Combined Declaration of Use and Incontestability under Sections 8 & 15 filed on September 10, 2009 with respect to Reg. ‘325 as Principal of Registrant.

3. On February 25, 2003, by application assigned serial number 78,218,644 (the “Application”), Hod applied to register the mark TOP GUN in International Class 25 (“IC 25”) alleging a date of first use of July 6, 1996 and a date of first use in commerce of July 6, 1996 (the “Claimed First Use Date”). Reg. ‘325 issued on February 24, 2004 registering the mark TOP GUN in IC 25 for the following listed goods: “Footwear, shoes, sandals; Clothing, namely, leather jackets, sports coats, jeans, sweatshirts, T-shirts, caps, hats, belts, and excluding protective clothing and work gloves” (the “Listed Goods”).

Petitioner’s Prior Use of the Mark TOP GUN on or in Connection with Certain Goods in IC 25

4. Petitioner is a designer, developer, producer and marketer of men’s, women’s, and children’s apparel and other products. Petitioner’s products are sold and distributed throughout the United States, directly to consumers through its catalogs, website and retail store, and indirectly by sales, at wholesale, to brick-and-mortar stores and catalog and online retailers.

5. In business since 1977, Petitioner has long been known to consumers and to retailers as a source, among other things, for military styled flight jackets, including the “G-1” jacket, a leather jacket with a fur collar issued to naval aviation officers and enlisted personnel on flying status. Issued without patches adorning the exterior, it is and has been the practice of aviators, particularly naval aviators, to decorate the exterior of their G-1 jackets with patches. Petitioner developed, promoted, marketed and sold G-1 jackets commercially with and without patches.

6. “Top Gun” is the colloquial term for the United States Navy Strike Fighter Tactics Instructor program which teaches advanced fighter weapons flight tactics to select Navy pilots. The term was popularized through the Paramount Pictures’ movie entitled “Top Gun,” starring Tom Cruise. In the movie, released in the U.S. in May of 1986, actors, including Mr. Cruise, wore G-1 jackets with patches similar to the G-1 jackets worn by pilots in the Navy’s Top Gun program and similar to the G-1 jackets which had been and then were being marketed and sold by Petitioner.

7. In connection with the “Top Gun” movie, Petitioner and Paramount Pictures entered into a license agreement for the use of the mark TOP GUN. Pursuant to the license agreement, Petitioner used the mark TOP GUN on and in connection with certain items of apparel.

8. After the license agreement ended, Petitioner continued, and continues, using the mark TOP GUN to identify certain of its apparel products, including its G-1 leather jacket with patches (the “Top Gun Jacket”), in connection with the marketing and sale of such products at wholesale and retail. Such use of the mark TOP GUN by Petitioner preceded the Claimed First Use Date of Reg. ‘325.

Business Relationship Between Petitioner and Hod

9. Upon information and belief, Hod caused the incorporation in the State of New York of T.G. Request, Inc. (“T.G. Request”) on June 17, 1996, and at all times relevant herein, Hod owned all of the shares of stock in T.G. Request or otherwise controlled T.G. Request.

10. Upon information and belief, T.G. Request was organized by Hod to operate a multi-brand retail store on Steinway Street in Astoria, New York under the name “Top Gun” (the “Store”). Later, other retail stores were opened by T.G. Request under the name “Top Gun.” At some point in time, after opening the Store, Hod also established an online retail outlet for his products at www.topgunstore.com (“Online Store”).

11. Upon information and belief, the first use of the mark TOP GUN in commerce on IC 25 goods by Hod, as claimed by Hod in the Application, occurred through T.G. Request. Before the use by Hod or by T.G. Request of the mark TOP GUN on goods in IC 25, Hod knew that Petitioner was using the mark TOP GUN in commerce in connection with certain of its IC 25 goods, including its Top Gun Jacket.

12. During the period July 1996 to March 2003, T.G. Request purchased apparel products from Petitioner for resale. Among the apparel products purchased by T.G. Request from Petitioner were Top Gun Jackets. The first purchases of Top Gun Jackets by T.G. Request from Petitioner occurred in July 1996 and thereafter continued to occur throughout 1997, 1998, 1999, 2000, 2001 and 2002, with the final such purchase occurring in March 2003.

13. Before the filing of the Application, Hod knew that Petitioner had been using the mark TOP GUN in commerce in connection with IC 25 goods and that Petitioner’s use preceded Hod’s or T.G. Request’s first use of the mark TOP GUN on or in connection with IC 25 goods.

Registrant's Threats of Legal Action against Customers of Petitioner

14. U.S. Wings, Inc. and My Plane, Inc. are online retailers of aviation related products. U.S. Wings, Inc. operates the website uswings.com. My Plane, Inc. operates the website mypilotstore.com. Each is a customer of Petitioner and each advertises and sells the Petitioner's Top Gun Jacket on its website.

15. Registrant, through its attorneys, sent a letter to U.S. Wings, Inc. stating that U.S. Wings, Inc. by featuring Petitioner's Top Gun Jacket on its site was infringing on Registrant's rights to Reg. '325, and, among other things, demanding that U.S. Wings, Inc. cease and desist using the term Top Gun in connection with leather jackets and threatening to take legal action against it if it fails to do so.

16. Registrant, through its attorneys, sent a letter to My Plane, Inc. stating that My Plane, Inc. by featuring Petitioner's Top Gun Jacket on its site was infringing on Registrant's rights to Reg. '325, and, among other things, demanding that My Plane, Inc. cease and desist using the term Top Gun in connection with leather jackets and threatening to take legal action against it if it fails to do so.

17. Upon information and belief, Registrant has already or intends to threaten other of Petitioner's customers.

18. Petitioner will suffer damage if as a result of Registrant's threats any of its customers cease purchasing its products.

Registrant's Fraud on the USPTO in Procurement of Registration No. 2,817,325

19. In the Application, Hod declared that he knows of no other person, firm, corporation, or association that has the right to use the mark TOP GUN (the "Mark") in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods listed of such other person, to cause confusion, or to cause mistake, or to deceive. Hod's declaration was false in that prior to filing the Application, Hod knew that prior to the Claimed First Use Date, Petitioner had been using the Mark in commerce, and had the right to use the Mark in commerce, in connection with goods listed in the Application.

20. Hod made the false declaration of a material fact in the Application with the intent to deceive the USPTO to obtain registration of the Mark in IC 25.

21. Reg. '325 was fraudulently obtained by the Registrant's Principal and predecessor, Hod. As such, Reg. '325 is invalid and must be cancelled.

Registrant's Fraud on the USPTO in the Combined Declaration of Use and Incontestability under Sections 8 & 15 for Registration No. 2,817,325 (the "Combined Declaration")

Section 8 Declaration of Use

22. On September 10, 2009, Registrant filed a Declaration of Use as part of the Combined Declaration for its Registration in the Mark.

23. In the Combined Declaration, Hod, as Principal of Registrant, made a false representation of a material fact in the Declaration of Use. At the time he made such declaration he knew it was not true, and as such Registrant has committed fraud on the USPTO that requires cancellation of Reg. '325.

24. In the Declaration of Use portion of the Combined Declaration, Hod declared that “For International Class 025, the mark is in use in commerce on or in connection with **all** of the goods or services listed in the existing registration for this specific class; . . .” (emphasis in original). However, as part of the Combined Declaration filing, Registrant only provided specimens for six of the ten Listed Goods.

25. Based on the personal investigation of Petitioner’s counsel, on or about September 11, 2012 and again on or about January 4, 2013, the Online Store was not offering shoes, sandals, sports coats, or jeans for sale. (See Exhibit A, a copy of items sold by the Online Store on or about January 4, 2013). Whether Registrant used the Mark in commerce in connection with the offer of sale of shoes, sandals, sports coats, or jeans at the time of the Combined Declaration is essential information uniquely within the control of Registrant.

26. Upon information and belief, and upon the results of the investigation, on September 10, 2009, Registrant was not using the Mark in commerce in connection with shoes.

27. Upon information and belief, and upon the results of the investigation, on September 10, 2009, Registrant was not using the Mark in commerce in connection with sandals.

28. Upon information and belief, and upon the results of the investigation, on September 10, 2009, Registrant was not using the Mark in commerce in connection with sports coats.

29. Upon information and belief, and upon the results of the investigation, on September 10, 2009, Registrant was not using the Mark in commerce in connection with jeans.

30. Registrant's declaration in the Combined Declaration that the Mark is in use in commerce on or in connection with **all** the Listed Goods is false, and Registrant submitted the said false declaration with the intent to deceive the USPTO to continue registration of the Mark in IC 25 for each of the Listed Goods.

31. By reason of the foregoing, Reg. '325 was fraudulently continued by the Registrant for all the Listed Goods. As such, Reg. '325 is invalid and must be cancelled.

Section 15 Declaration of Incontestability

32. On September 10, 2009, Registrant filed a Declaration of Incontestability as part of the Combined Declaration.

33. In the Combined Declaration, Hod, as principal of Registrant, made a false representation of a material fact in the Declaration of Incontestability. At the time he made such declaration he knew it was not true, and as such Registrant has committed fraud on the USPTO that requires cancellation of Reg. '325.

34. In the Declaration of Incontestability portion of the Combined Declaration, Hod declared that "the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, . . . and is still in use in commerce on or in connection with **all** goods or services listed in the existing registration for this class" (emphasis in original), which declaration is false.

35. Based on the personal investigation of Petitioner's counsel, on or about September 11, 2012 and again on or about January 4, 2013, the Online Store was not offering shoes, sandals, sports coats, or jeans for sale. (*See Exhibit A*). Whether Registrant used the Mark continuously in commerce in connection with the offer of sale of shoes, sandals, sports coats, or jeans for the five consecutive years after the date of Registration is essential information uniquely within the control of Registrant and/or Hod.

36. Upon information and belief, and upon the results of the investigation, on September 10, 2009, Registrant had not used the Mark in commerce in connection with shoes continuously for five consecutive years since the date of Registration.

37. Upon information and belief, and upon the results of the investigation, on September 10, 2009, Registrant had not used the Mark in commerce in connection with sandals continuously for five consecutive years since the date of Registration.

38. Upon information and belief, and upon the results of the investigation, on September 10, 2009, Registrant had not used the Mark in commerce in connection with sports coats continuously for five consecutive years since the date of Registration.

39. Upon information and belief, and upon the results of the investigation, on September 10, 2009, Registrant had not used the Mark in commerce in connection with jeans continuously for five consecutive years since the date of Registration.

40. Registrant's declaration in the Combined Declaration that it used the Mark in commerce on all the Listed Goods continuously for five consecutive years and was still using the Mark in commerce on all the Listed Goods as of the date of the declaration is false.

41. Registrant submitted the declaration with this false information with the intent to deceive the USPTO to obtain incontestability status of Registrant's registration of the Mark in IC 25 for each of the Listed Goods.

42. By reason of the foregoing, incontestability status for all the Listed Goods was fraudulently obtained by Registrant. As such, Reg. '325 is invalid and must be cancelled.

In the Alternative - Reg. '325 Should Be Cancelled as Generic in IC 25 as to Leather Jackets

43. As a result of Paramount Picture's Top Gun movie and the commercial efforts of Petitioner and others, the term "Top Gun" has become synonymous with flight jackets. As such, the use of the identifier Top Gun with such jackets has become generic.

44. With the Mark now generic for flight jackets in International Class 25, Reg '325 should be cancelled insofar as it includes "leather jackets."

WHEREFORE, the Petitioner, through its attorneys, Rand Rosenzweig Radley & Gordon LLP, requests that Registration No. 2,817,325 be cancelled. Alternatively, if Registration No. 2,817,325 is not cancelled in its entirety, registration as to "leather jackets" should be cancelled as generic.

Dated: June 20, 2014

Respectfully submitted,

/s/ Catherine S. Campbell
Catherine S. Campbell

RAND ROSENZWEIG RADLEY
& GORDON, LLP
Attorneys for Petitioner
445 Hamilton Avenue, Suite 1201
White Plains, New York 10601

EXHIBIT A



[MEN](#) | [WOMEN](#) | [KIDS](#) | [ACCESSORIES](#) | [SALE](#)



Women

Jackets

- › Short
- › Racing
- › Hipsters
- › Bombers
- › Coats

Tops

- › Hoodies
- › Tees
- › Shirts

Bottoms

- › Pants
- › Cargo Shorts

Accessories

- › Hats
- › Belts
- › Wallets
- › Sunglasses
- › Fragrance





[MEN](#) | [WOMEN](#) | [KIDS](#) | [ACCESSORIES](#) | [SALE](#)

SEARCH TOP GUN®



Coats « Jackets « Women

Jackets

- › Short
- › Racing
- › Hipsters
- › Bombers
- › Coats

Tops

- › Hoodies
- › Tees
- › Shirts

Bottoms

- › Pants
- › Cargo Shorts

Accessories

- › Hats
- › Belts
- › Wallets
- › Sunglasses
- › Fragrance

Refine by:
[New Arrivals](#) [Military](#) [Big & Tall](#) [Vintage](#) [Gifts](#) [On Sale](#)



Short Military Fur-Lined Jacket
TGJ1053 :: \$200.00



Military Fur-Lined Jacket
TGJ1052 :: \$280.00



Luxurious Women's Coat
TG9163 :: \$649.99 | \$549.99





MEN | WOMEN | KIDS | ACCESSORIES | SALE

SEARCH TOP GUN®



Pants « Bottoms « Women

Jackets

- › Short
- › Racing
- › Hipsters
- › Bombers
- › Coats

Tops

- › Hoodies
- › Tees
- › Shirts

Bottoms

- › Pants
- › Cargo Shorts

Accessories

- › Hats
- › Belts
- › Wallets
- › Sunglasses
- › Fragrance

Refine by:

New Arrivals Military Big & Tall Vintage Gifts On Sale



MISS TOP GUN PINUP LOUNGE PANTS

TGP1052 :: \$50.00



MISS TOP GUN LOUNGE PANTS

TGP1051 :: \$50.00



MISS TOP GUN® MILITARY CARGO PANTS

TGC1051 :: \$70.00





[MEN](#) | [WOMEN](#) | [KIDS](#) | [ACCESSORIES](#) | [SALE](#)

[JACKETS](#) [TOPS](#) [BOTTOMS](#) [ACCESSORIES](#)



Men

Jackets

- › Short
- › Racing
- › Hipsters
- › Bombers
- › Shearlings
- › Big & Tall

Tops

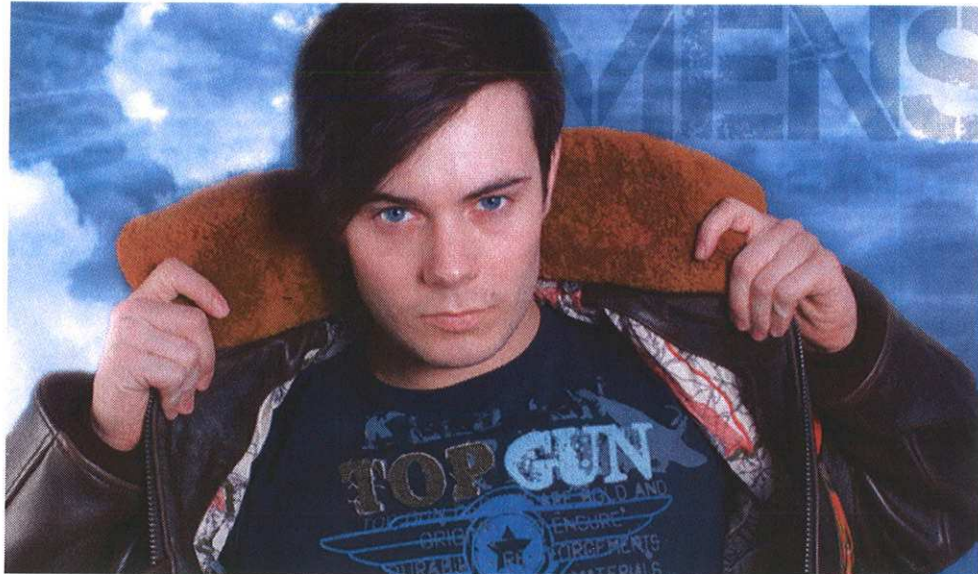
- › Hoodies
- › Tees
- › Shirts

Bottoms

- › Cargo Shorts

Accessories

- › Hats
- › Belts
- › Wallets
- › Sunglasses
- › Watches
- › Fragrance





[MEN](#) | [WOMEN](#) | [KIDS](#) | [ACCESSORIES](#) | [SALE](#)

SEARCH TOP GUN®



Cargo Shorts « Bottoms « Men

Jackets

- › Short
- › Racing
- › Hipsters
- › Bombers
- › Shearlings
- › Big & Tall

Tops

- › Hoodies
- › Tees
- › Shirts

Bottoms

- › Cargo Shorts

Accessories

- › Hats
- › Belts
- › Wallets
- › Sunglasses
- › Watches
- › Fragrance

Refine by:

- ☒ New Arrivals [Military](#) [Big & Tall](#) [Vintage](#) [Gifts](#) [On Sale](#)



KAMIKAZE Cargo Pants
TGC1006 :: \$70.00



LEGIONNAIRE Cargo Pants
TGC1001 :: \$70.00



COMMANDO Cargo Pants
TGC1002 :: \$70.00





[MEN](#) | [WOMEN](#) | [KIDS](#) | [ACCESSORIES](#) | [SALE](#)



Accessories « All

Jackets

- › Short
- › Racing
- › Hipsters
- › Bombers
- › Coats
- › Shearlings
- › Big & Tall

Tops

- › Hoodies
- › Tees
- › Shirts

Bottoms

- › Pants
- › Cargo Shorts

Accessories

- › Hats
- › Belts
- › Wallets
- › Sunglasses
- › Watches
- › Fragrance

